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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/666,733 | 09/20/2000 | James A. Creighton | P04589US0 | 6043 |

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 03/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,733

Applicant(s)

Creighton et al.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2-8 and 13, drawn to an apparatus with a specific guide mechanism configuration, classified in class 83, subclass 646.
 - II. Claims 1, 9 and 10, drawn to an apparatus with a clamp, classified in class 83, subclass 452.
 - III. Claims 1, 11 and 12, drawn to an apparatus with stop members, classified in class 83, subclass 859.
 - IV. Claims 14, 15 and 16, drawn to a method for using a knife with a specific work piece and specific work piece handling steps, classified in class 83, subclass 35.
 - V. Claims 14 and 17-20, drawn to a method for using a knife with specific knife manipulation steps, classified in class 83, subclass 13.
2. Claims 1-12 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the specific guide mechanism configuration of Group I). It is noted that if claim 1 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 1-12 will be considered. It is further noted that claim 1 is listed as part of groups I-III but is not considered to be part any of these groups. Rather, claim 1 recites subject matter that is common to all of these groups and has been shown as part of each group for

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clarity (i.e., so that it is clear which claims are part of which group). Further, because claim 1 includes subject matter that is common to all of these groups, it is not considered to be independent or distinct from any of these groups. Therefore, claim 1 will be examined upon election of one of the groups with which it is listed. The same applies to claim 14 with respect to the claims dependent therefrom.

3. The inventions are distinct, each from the other because of the following reasons:

Method Groups (IV-V) vs Apparatus Groups (I-III)

4. Inventions IV and V are related to Inventions I-III as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus, by a plurality of apparatuses or by hand. Further, the apparatus as claimed can be used to practice another and materially different process; for example, cutting different work pieces in different directions, rather than cutting the same work piece in different directions.

Apparatus Groups (I-III)

5. Inventions of group I and group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

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shown to be separately usable. In the instant case, the specific guide mechanism configuration (e.g., the linkage mechanism) of group I could be employed without the clamp of group II; and conversely, the clamp of group II could be employed without the specific guide mechanism configuration of group I. See MPEP § 806.05

6. Inventions of group I and group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the specific guide mechanism configuration (e.g., the linkage mechanism) of group I could be employed without the stop members of group III; and conversely, the stop members of group III could be employed without the specific guide mechanism configuration of group I. See MPEP § 806.05

7. Inventions of group II and group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the clamp of group II could be employed without the stop members of group III; and conversely, the stop members of group III could be employed without the clamp of group II. See MPEP § 806.05

Method Groups (IV-V)

8. Inventions of group IV and group V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the specific work piece (e.g., the book) and the

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handling steps thereof of group IV could be employed without the knife manipulation steps of group V; and conversely, the knife manipulation steps of group V could be employed without the specific work piece and work piece handling steps of group IV. See MPEP § 806.05(d).

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
March 7, 2002